REMARKS

Claims 1-43 were originally presented in the subject application. Claims 18-43 were canceled without prejudice, and claims 44-62 added in a response dated March 19, 2003. Claims 1, 8, 9, 15, 45, 49, 56, 58 and 59 have hereinabove been amended to more particularly point out and distinctly claim the subject invention. No claims have herein been added or canceled. Therefore, claims 1-17 and 44-62 remain in this case.

The addition of new matter has been scrupulously avoided. In that regard, support for the common amendment to claims removing "specific gravity" in favor of --density-- can be found in the claims as originally filed. In addition, support for the common amendment to claims 8, 9, 45, 49 and 56 can be found, for example, in the specification at page 5, lines 1-11.

Applicant respectfully requests reconsideration and withdrawal of the grounds of rejection and objection.

35 U.S.C. §112 Rejection

The Office Action rejected claims 8, 45-55 and 57-62 under 35 U.S.C. §112, as allegedly failing to enable thermal isolation by means other than an air gap in the exiting channel. Applicant respectfully, but most strenuously, traverses this rejection.

As an initial matter, Applicant submits the Office Action fails to consider all the factors required under MPEP 2164.01(a), providing a non-exhaustive list of factors (A) though (H) to be considered in any enablement determination:

(A) The breadth of the claims;
(B) The nature of the invention;
(C) The state of the prior art;
(D) The level of one of ordinary skill;
(E) The level of predictability in the art;
(F) The amount of direction provided by the inventor;
(G) The existence of working examples; and
(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Therefore, Applicant submits that the Office Action fails to present even a *prima facie* case of non-enablement. Should this rejection be maintained, Applicant requests that each and every factor be adequately addressed in the next Office Action.

Moreover, as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. §112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. §112. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.) *cert. denied*, 484 U.S. 954 (1987).

Further, although in this case there is a working example, Applicant submits not even that is required for enablement. See MPEP 2164.02.

For all the reasons noted above, Applicant submits that the rejected claims are adequately enabled, such that this rejection should be withdrawn.

The Office Action also rejected claims 1-17, 44-55 and 57-62 as allegedly indefinite, based on the use of units of density with "specific gravity." In response, Applicant has amended claims 1, 15, 58 and 59 to recite "density," rather than "specific gravity," and keeping the existing units of density. Applicant similarly amended the specification.

The Office Action further rejected claims 8, 45-55 and 57-62 as indefinite, alleging that the phrase "at least partially thermally isolating the first portion from the second portion" is vague, in that one skilled in the art could not establish when the portions were at least partially thermally isolated from each other.

In response, Applicant has amended claims 8, 9, 45, 49 and 56 to remove the objectionable language, and instead focus on controlling pre-foaming in the expanding portion of the die (i.e., the second portion in the claims). Controlling pre-foaming is the overall purpose of the thermal isolation.

As amended, Applicant submits the above-noted rejection of claims 8, 45-55 and 57-62 has been overcome.

35 U.S.C. §103 Rejection

The Office Action rejected claims 1-3 and 14-17 under 35 U.S.C. §103, as allegedly obvious over Wu et al. (U.S. Patent No. 6,383,425) in view of Wilkes et al. (U.S. Patent No. 5,817,705). Applicant respectfully, but most strenuously, traverses this rejection.

As pointed out in Applicant's prior response, Wu et al. teaches extruding foam with densities in the range of 0.4 to 0.8 g/cc. Recognizing this fact, the Office Action seeks to combine Wilkes et al. for its density teaching, arguing simply that "[i]t would have been obvious to one of ordinary skill in the art to operate the process of Wu et al. in a manner to produce a foam having a density within the range taught by Wilkes et al. in order to meet commercial demand for foams having such a density."

However, Applicant submits there is no indication in Wu, and no other evidence provided in the Office Action, as to whether polymer foam having a density of less than about 0.15 g/cc could even be produced with the Wu et al. die. In fact, Applicant submits that such low-density foam could not be produced using the die of Wu et al., without major modifications taught by the present invention. Indeed, if Wu et al. were able to produce foam at lower densities, one would think that such lower densities would have been disclosed in the specification and, if allowable over the art, claimed as well. Yet, such is not the case; Wu et al. teaches only the range 0.4 to 0.8 g/cc, well above the claimed density of less than about 0.15 g/cc.

Even if, for the sake of argument, and Applicant does not believe this to be true, one were to assume that Wilkes et al. somehow suggests using the Wu et al. die to produce foam of the claimed density, the question remains how to do it such that the claim language would be met. What is claimed is not just low-density foam, but foam with a density of less than about 0.15 g/cc **AND** comparable in quality to that obtainable with hydrocarbon blowing agents. Applicant submits this aspect is not taught or suggested in either reference or their combination, without resort to the present invention.

Moreover, Applicant submits that the reasoning in the Office Action as to why it would be obvious to combine the references in the manner alleged evidences the use of hindsight, since there is no teaching or suggestion within the references themselves, as required in the case law, for modifying the Wu et al. die to produce low-density foam. This is especially true in this case, since Wu et al. expressly teaches in a density range nowhere near what is claimed.

Therefore, Applicant submits that claim 1 cannot be rendered obvious over Wu et al. in view of Wilkes et al.

Objection to Claims

The Office Action objected to claims 9, 12, 13 and 56 as depending from a rejected base claim. However, the Office Action also indicated that these claims would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims, and, for claims 9, 12 and 13, if the rejection under 35 U.S.C. §112, second paragraph, were overcome.

Applicant sincerely appreciates the indication of allowable subject matter, however, in light of the remarks made above, Applicant respectfully declines at this time to so amend the noted claims. Applicant does, however, reserve the right to do so later in prosecution.

CONCLUSION

Applicant submits that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicant maintains that the claims of the subject application define patentable subject matter and earnestly requests allowance of claims 1-17 and 44-62.

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If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided.

Wayne F. Reinke
Attorney for Applicant
Registration No.: 36,650

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HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579

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